

REMARKS

Claims 1 to 6 are in the case.

With this amendment, reference numeral 44 has been added to the drawings and is thus believed to overcome the Examiner's objections thereto.

The Disclosure has been amended to overcome the Examiner's objection to the specification.

With respect to the claims, Claims 1 and 6 have been carefully revised in order to define over the art of record.

In this regard, Claim 1 has been revised to more precisely define and limit the claim to the illustrated embodiment wherein there is provided a slit located at the end of the tubular sheath, this end also having the securement means located thereon. Claim 6 has been limited in a similar manner.

McGowan teaches a protective cover for crutches and which does not have the constant diameter sheath called for in Claim 1.

Muk Kim teaches a decorative cover for fishing rods and the same and cannot respond to the limitation of the slit and securement means.

With respect to the rejection under 35 USC 103, it is not believed that Simek adds anything to the remaining references as applied against newly revised claims 1 and 6.

As for the proposed combination of references, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of Applicant's invention as defined now in the amended Claim 1, any hypothetical construction produced by this combination would not lead to Applicant's invention.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue.

There is nothing in the cited art to suggest what Applicant did. In fact, these references do not even contain any suggestion that they could be combined in the manner proposed by the Examiner. However, this is a prerequisite for a combination rejection, as stated by the Patent Office Board of Appeals in its decision in *Ex parte Walker*, 135

USPQ 195:

"In order to justify combination of references it is necessary not only that it be physically possible to combine them, but that the art should contain something to suggest the desirability of doing so."

The Court of Customs and Patent Appeals subscribed to the Board's reasoning, when it handed down its decision in the case *In re Imperato*, 179 *USPQ* 730, holding:

"The fact that the disclosures of references can be combined does not make combination obvious unless the art also contains something to suggest the desirability of such a combination."

With regard to the principal rejection, we agree that combining the teaching of Schaefer with that of Johnson or Amberg would give the beneficial result observed by appellant.

However, the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. In re Bergel, 48 CCPA 1102, 292 F.2d 955, 130 USPQ 206 (1961). We find no such suggestion in these references."

In fact the art must not only be combinable in accordance with the principles of the above decisions, but to support a valid combination rejection the art must also suggest that the combination would accomplish Applicant's results. This was stated by the Patent

Office Board of Appeals in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

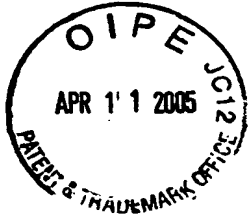
"Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish Applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices."

It is also well settled that an inventive combination cannot be anticipated by finding individual features separately in the prior art and combining them in a piecemeal manner to show obviousness. Note would be taken in this connection of the decision of the Court of Customs and Patent Appeals *In re Kamm and Young*, 17 USPQ 298 ff, which appears most pertinent to the issues at hand and wherein the claims were also rejected over a combination of references. The Court held that:

"The rejection here runs afoul of a basic mandate inherent in section 103 - that 'a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960). 'It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.' In re Wesslau, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965)."
Emphasis added.

The mere fact that an invention is simple and accomplishes only a small but genuine improvement is not sufficient reason to deny it patent protection.

In Schnell et al v. The Allbright-Nell Co. et al, 146 USPQ 322, the U.S. Court of Customs and Patent Appeals held that:



"Device seems simple and obvious in light of patentee's teaching, but it evidently was not obvious at time of invention; those working in the field did not accomplish patentee's results; that fact supports conclusion that patentee achieved patentable invention."

The Board of Appeals expressed the same concept when it held, in *Ex parte Grasenick and Gessner*, 158 USPQ 624, that

"Improvement over prior art, even though it be simple or involved only a reversing of certain parts, is patentable unless prior art shows that improvement is obvious."

Attention is also directed to *Mercantile National Bank of Chicago et al v. Quest, Inc. et al. D.C., N.D., Indiana*, 166 USPQ 517, *In re Shelby*, 136 USPQ 220, and *In re Irani and Moedritzer*, 166 USPQ 24, which all indicate that simplicity does not operate as a bar to patentability, if the invention was unobvious at the time it was made.

It is respectfully submitted that when the rejection of the claims is reviewed in light of Applicant's arguments, the invention without a doubt should be considered patentably distinguished over the currently applied references.

Respectfully,

A handwritten signature in black ink, appearing to read "Eric Fincham".

Eric Fincham
Reg. 28,201

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope addressed to: Mail Stop - Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 11, 2005

Express Mail : ER 422071852 US

A handwritten signature in black ink, appearing to read "Eric Fincham".
Eric Fincham, Reg. 28,201

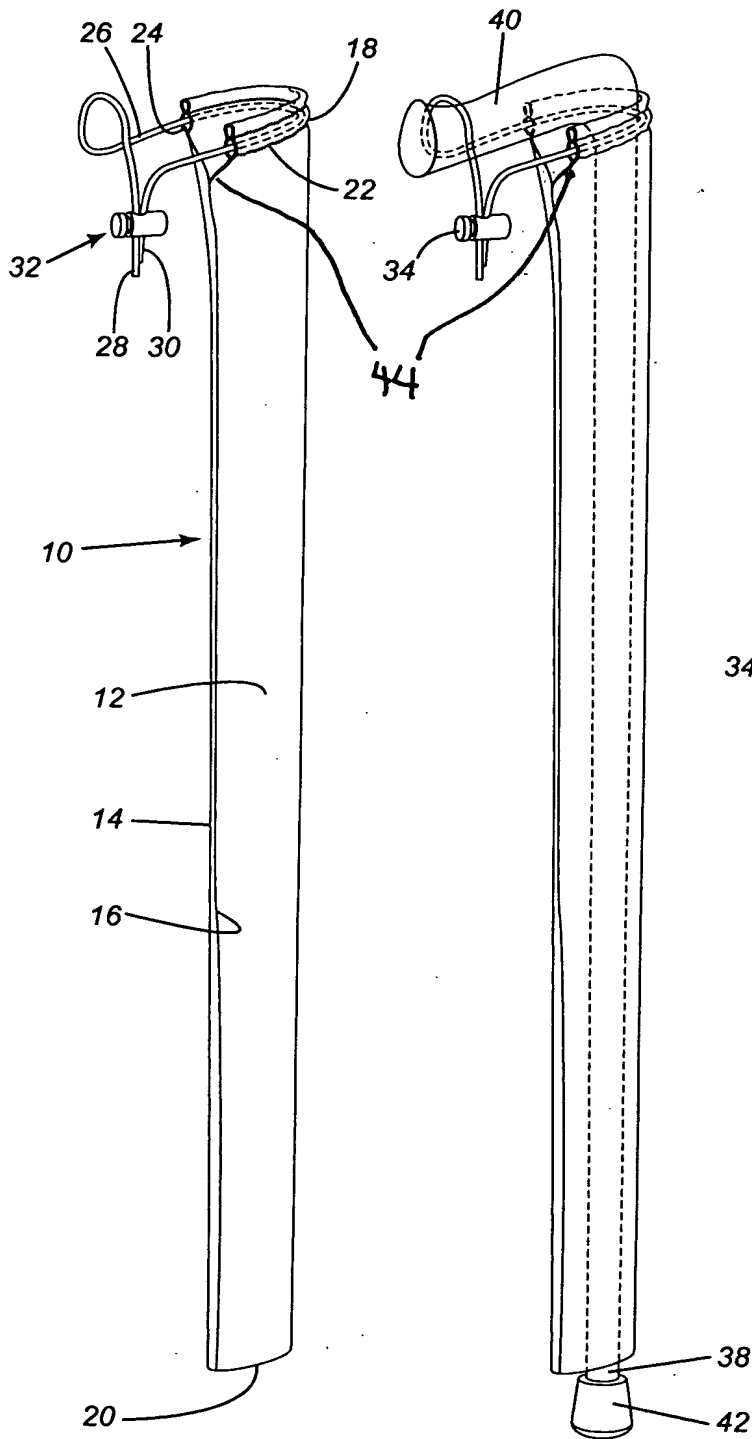
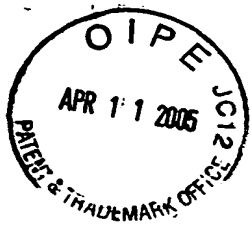


Fig-1

Fig-2

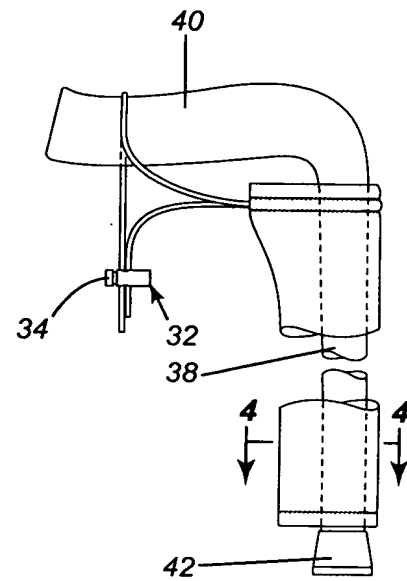


Fig-3



Fig-4